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Draft amendment of Spanish Patent Act aimed at admitting the protection of pharmaceutical substances and compositions via utility models

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After four years of experience with Spanish Act 24/2015, of 24 July, on Patents (the “new Patent Act”), which came into force on 1 April 2017, the time seems ripe now to update some aspects of the Act that could be further improved. In this vein, earlier this year the Spanish Patent and Trademark Office (“SPTO”) published a draft text of amendments that, among other improvements, admits the protection of pharmaceutical substances and compositions via utility models.

The text of Article 137.2 of the new Patent Act, currently in force, explicitly excludes pharmaceutical substances and compositions from protection via utility models. According to the amendment proposed, Article 137 would read as follows:

Article 137. Inventions that can be protected as utility models.

1. Pursuant to the provisions of this Title, inventions that are susceptible of industrial application, that are new and involve an inventive step, and that confer upon an object or product a form, structure or composition resulting in a practically discernible advantage for their use or manufacture, can be protected as utility models.

2. In addition to the matters and inventions that cannot be patented in application of Articles 4 and 5 of this Act, process inventions and those which consist of biological matter cannot be protected as utility models.

So, according to the amendment proposed, the exclusions from protection via utility model would be limited to those envisaged for patents, plus process inventions and those which consist of biological matter.

The proposed amendment has been inspired by the experience in Germany, where utility models have traditionally been used as a complement or alternative to patent protection. Clearly, it will benefit companies of all sizes but, in particular, small and medium-sized pharmaceutical companies, which will be able to thereby accelerate the process of obtaining protection for their pharmaceutical inventions. After the introduction of the compulsory examination of patents in the new Patent Act that came

into force in 2017, the modernization of the utility model is the next logical step.

Another aspect of the amendments proposed is the introduction of “derivative” utility models, which are roughly similar to “divisional” patent applications. According to Article 147 bis of the new text proposed:

Article 147 bis: Derivative utility models

1.If the applicant had previously submitted a patent application effective in Spain, it may apply for a utility model derived therefrom, for essentially the same invention. The application for a derivative utility model will maintain the submission date of the previous patent and its priority date, as the case may be.

2.The derivative utility model application must be submitted within the term expiring prior to the following:

i) throughout the entire process for the previous patent application or the process for the opposition proceedings, and until two months have passed as from the last day of the month when the decision to grant the patent was issued or when the decision in the opposition proceedings was issued;

ii) ten years, as from the application submission date of the previous patent.

3. If an application has been submitted for a derivative utility model, the Spanish Patent and Trademark Office will request that the applicant provide the file number and submission date, as well as a copy of the previous patent application within the following two months, unless such copy is on file at the Spanish Patent and Trademark Office or is available online in a digital repository accepted by it. If such information is not provided by the established deadline, the derivative utility model application will be considered withdrawn.”

All in all, the proposed amendments form part of the efforts deployed by the SPTO in recent years to modernize Spanish patent law which, historically, has lagged behind the standards applied in countries with more advanced patent systems. Hopefully, these initiatives will help to leave behind the embarrassment for not having admitted the patentability of pharmaceutical products until 1992 and for not having introduced examined patents until 2017.

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This entry was posted on Monday, November 29th, 2021 at 6:20 pm and is filed under [Spain](#), [Utility model](#)

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